

REMARKS

By this amendment, claims 1-16 are canceled, and the drawings, specification and claim 17 are revised to place this application in condition for allowance. Applicants contend that claims 17-23 are before the Examiner for consideration on their merits.

First, the Examiner alleges that claims 20 and 21 are withdrawn from consideration. Applicants submit that the features of claim 20 are common to both of Figures 5a and 7 so that election of either Figure requires that claim 20 be examined. Claim 20 requires that the load bearing surface of the first portion of the body to have a width less than a width the load bearing surface of the second portion. This is plainly evident in Figure 7 wherein first portion 49 is narrower than second portion 51. Claim 20 also requires a first segment of the at least one rib aligned with the first portion to have a width less than a width of a second segment of the at least one rib aligned with the second portion, the differences in width creating a stop between the first and second portions and allowing the ring to slide over the first portion and first segment and reach the notch, the stop limiting rotation of the ring. Therefore, whatever differences that may exist between Figures 5a and 7, the features of claim 20 are found in both so that claim 20 should be examined with claim 17. Claim 21 is specific to the embodiment of Figure 5a so that it is properly withdrawn from consideration.

Also, Applicant indicated that claim 20 was included in the elected species so that it is improper for the Examiner to say that an election was made without traverse.

Applicant traverses the objection to the drawings for failing to disclose a protrusion. First, Rule 1.81(a) requires a drawing when necessary for the

understanding of the invention. The description of protrusions on the load bearing surface does not need illustration since one of skill in the art would clearly understand the meaning of this aspect of the disclosure. Nevertheless, Applicant is submitting a new drawing to provide an illustration of the subject matter of claim 22. No new matter is introduced since new Figure 5C merely shows the protrusions as set forth in claim 22.

Applicant also traverse the rejection claim 22 under 35 U.S.C. § 112, first paragraph. The test of whether claim 22 satisfies the written description requirement is whether there is sufficient written description to inform a skilled artisan that applicant was in possession of the invention at the time of filing. An adequate written description may be shown by any description so long as a person of skill in the art would recognize that the inventor had possession of the claimed invention. In this case, claim 22, which is part of the disclosure, clearly teaches that one or more protrusions can be located on the load bearing surface to improve grip. One of skill in the art would readily understand the meaning of this phrase. The fact that a particular shape of the protrusion is not disclosed is not fatal since one of skill in the art would readily understand that various shaped protrusions exist and that the point of this aspect of the invention is the presence of a protrusion, not its particular shape.

Based on the above, claim 22 is in compliance with 35 U.S.C. § 112, first paragraph, and the rejection should be withdrawn.

In response to the rejection based on 35 U.S.C. § 112, second paragraph, claim 17 is revised to include "a" prior to load on the last line thereof. Claim 20 is also revised to correct an error therein.

Applicant traverses the allegation that claim 17 is indefinite because of a lack of antecedent basis with respect to the load bearing surfaces. The load bearing surface is defined as being part of the first and second portions. Therefore, each of the first and second portions has a load bearing surface and the longitudinal rib runs parallel to the surfaces. Therefore, the use of bearing surfaces in claim 17 is not improper and the claim is not indefinite in this regard.

Finally, Applicant traverse the rejection based on 35 U.S.C. § 102(b) and United States Patent No. 4,120,441 to Hurley. In the rejection, the Examiner alleges that Hurley includes the first and second portions, the lengthwise rib and a notch. The Examiner considers the rib 14 to be the claimed rib and that it is parallel to the load bearing surface.

The rejection based on Hurley is no longer valid given the change to claim 17. Claim 17 is amended to make it clear that the rib is parallel to each of the load bearing surfaces of the first and second portions. This feature is not present in Hurley since the rib associated with portion 12 of Hurley is not parallel to the load bearing surface of portion 10; the rib 14 of portion 12 is perpendicular to the surface of portion 10. Therefore, the anticipation rejection is no longer valid and it must be withdrawn.

Moreover, there is no reason to modify Hurley by making the portions 10 and 12 on a plane such that it could be said that the ribs 14 are parallel to each portion. Hurley is specifically directed to an angle guard for shipping containers. Modifying Hurley to remove the 90 degree relation between portions 10 and 12 would destroy Hurley for its intended purpose and a modification of this nature would never be contemplated by one

of skill in the art. Therefore, Hurley cannot form the basis of a rejection of independent claims 17 and 23 based on 35 U.S.C. § 103(a).

Applicant also contends that Hurley does not teach the notch of claim 17 or the securing means of claim 23. In the rejection, the Examiner interprets the notch broadly to read on the corner groove 28 of Hurley. The problem with this approach is that Applicant is not claiming just a notch but a notch adapted to engage a ring so that the ring could be secured to the body. The groove 28 of Hurley is configured in such a way that it is unreasonable to say that it could be adapted to engage a ring. Since the groove is elongated, only its two ends would be able to even contact a ring. Moreover, a ring in the groove would interfere with the basic function of the guard of Hurley and one of skill in the art would not view the groove as a “notch adapted to engage a ring” as is required by claim 17.

The same argument applies for the means plus function of claim 23. One of skill in the art would not construe the elongated groove of Hurley as a means for securing a ring between the first and second body portions. This means that Hurley fails to teach the notch of claim 17 or the securing means of claim 23 and a *prima facie* case of anticipation cannot be said to exist.

There is also no reason to modify Hurley and include a securing means or notch adapted to secure a ring between the first and second body portions. As explained above, Hurley's two body portions are designed to fit between a shipping container and an object being shipped. One of skill in the art would not even think of employing a ring in the groove 28 given Hurley's intent and there is no basis to use Hurley in a rejection based on 35 U.S.C. § 103(a).

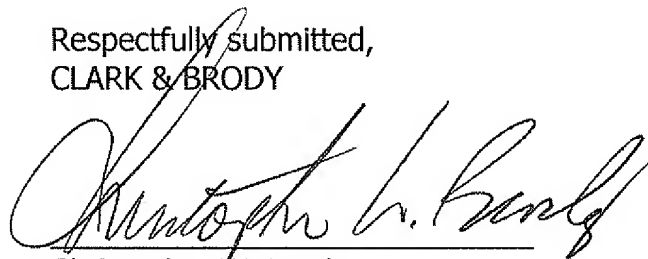
In addition, claim 20 is separately patentable over Hurley since the features defined in this claim are not found at all in Hurley. Moreover, since Hurley is fundamentally different from the invention, there is no reason that Hurley would be modified to include the limitations of claim 20.

Lastly, since generic claim 17 is patentable over Hurley, the species election requirement, if maintained, should be withdrawn and claims 20 and 21 be rejoined with claim 17 when this application is allowed.

In light of the above, all issues regarding the drawings, the specification, the indefiniteness rejection, the written description rejection, and the prior art rejection have been addressed. Accordingly, the Examiner is requested to examine this application in light of this response and pass all pending claims onto issuance.

Applicant respectfully submits that there is no fee required for this submission, however, please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,
CLARK & BRODY

A handwritten signature in black ink, appearing to read "Christopher W. Brody", written over a horizontal line.

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